

REMARKS

This response is intended as a full and complete response to the final Action mailed October 22, 2008. Claims 100-117, 121-139, 141-143, 145, 149-151, 153-157, 163-164 and 166-168 are pending and rejected.

In view of the following discussion, Applicants submit that none of the claims now pending in the application obvious under the respective provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

I. REJECTIONS UNDER 35 U.S.C. 103

A. Claims 121-128, 131-136, 141-143, 145, 149, 151, 153-157, 163-164 and 166-168

The Office Action rejects claims 121-128, 131-136, 141-143, 145, 149, 151, 153-157, 163-164 and 166-168 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,088,722 to Herz et al. ("Herz") in view of U.S. Patent No. 6,177,931 to Alexander et al. ("Alexander") and further in view of U.S. Patent No. 7,003,792 to Yuen et al. ("Yuen"). Applicants note that claims 144, 146, 148 and 158-161 are cancelled and respectfully traverse the rejection.

The Office Action fails to establish a *prima facie* case of obviousness, because the combination of Herz, Alexander and Yuen fails to teach or suggest all the claim elements. Applicants respectfully submit that Herz, Alexander and Yuen, alone or in any permissible combination fail to teach or suggest providing program recommendations to the user based on the profile of the user via an interactive programming guide having a top portion and a bottom portion, the top portion providing programming recommendations based on the profile of the user, the bottom portion providing a standard programming guide in numeric order based on a channel number, wherein said interactive programming guide automatically appears when the user turns on a television, as positively recited by Applicants' independent claim 121.

The Examiner concedes that Herz and Yuen fail to teach or suggest this limitation in the Office Action. (See Office Action, pp. 3-4). However, the Examiner

asserts that Alexander bridges the substantial gap left by Herz and Yuen. Applicants respectfully disagree.

Alexander fails to bridge the substantial gap between Herz and Yuen because Alexander also fails to teach or suggest providing program recommendations to the user based on the profile of the user via an interactive programming guide having a top portion and a bottom portion, the top portion providing programming recommendations based on the profile of the user, the bottom portion providing a standard programming guide in numeric order based on a channel number, wherein said interactive programming guide automatically appears when the user turns on a television. The Examiner is reminded that the MPEP § 2141.02(VI) requires the Examiner to consider the prior art in its entirety. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention". MPEP § 2141.02(VI), W.L. Gore & Associates, Inc., v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed Cir. 1983), cert. denied, 469 U.S. 851 (1984)(emphasis added).

Alexander clearly fails to teach or suggest wherein said interactive programming guide automatically appears when the user turns on a television. In fact, Alexander explicitly teaches away from this limitation of Applicants' invention. Alexander teaches that the viewer enters the Guide Mode by pressing a "select" key. (See Alexander, col. 3, ll. 56-57). In other words, Alexander teaches that a viewer must decide to enter the Guide Mode and manually press the "select" button to enter the guide mode. In stark contrast, Applicants' invention teaches wherein said interactive programming guide automatically appears when the user turns on a television.

At best, Alexander teaches that the EPG automatically tunes to a channel based upon the user profile. (See Alexander, col. 30, l. 59 – col. 31, l. 8). However, Alexander states that the grid guide may be re-formatted "whenever the viewer enters the Grid Guide." (See Alexander, col. 31, ll. 6-7, emphasis added). As noted above, Alexander explicitly teaches that the user must enter the Guide Mode by manually pressing the "select" button to enter the guide mode. Thus, Alexander clearly fails to teach or suggest wherein said interactive programming guide automatically appears when the user turns on a television. Thus, in Applicants' invention, the user may

immediately decide which program to watch after turning the user's television without needing to aimlessly surf channels.

In addition, Alexander teaches an electronic programming guide having a single portion for displaying available programming, whether the programming is in channel order or according to a customized view of the viewer's favorite channel. (See Alexander, FIGs. 1-10A). Notably, none of the figures illustrate an EPG that has two separate portions including a top portion and a bottom portion, the top portion providing programming recommendations based on the profile of the user, the bottom portion providing a standard programming guide in numeric order based on a channel number. FIGs. 1-10A only show a single grid portion in a "grid" format, a "sort" format or a "schedule" format. The Applicants would find it helpful if the Examiner could specifically identify a FIG in Alexander or a portion of the specification that the Examiner feels teaches this limitation, rather than general citations. For example, the Examiner's citation to col. 3, line 21- col. 4, line 27 teaches how the viewer must manually enter the Guide Mode, col. 5, lines 56 – col. 7, line 45 only describes the asserted "improvements to an EPG", notably none which discuss two separate programming guide portions, col. 14, line 48 – col. 15, line 1+ only discusses on-screen notifications, theme navigation bars, improved scrolling and jumping, col. 30, line 45 – col. 31, line 1+ only teaches that the grid guide may be customized and that a viewer must still manually enter the grid guide, but is silent as to teaching two separate programming guide portions.

In stark contrast, as previously argued, Applicants' invention teaches two separate programming guide portions. As a result, the viewer is simultaneously presented with both an option to select based on the top portion of the programming guide providing programming recommendations based on the profile of the user or to select based on the bottom portion of the programming guide providing a standard programming guide in numeric order based on a channel number. Thus, Applicants' invention provides more choices to the viewer than taught by Alexander. Therefore, the combination of Herz, Alexander and Yuen fail to render obvious Applicants independent claim 121.

Independent claims 149, 156, 163, 166 and 168 contain similar limitations and are patentable over Herz and Yuen under 35 U.S.C. §103 for at least the same reasons

that claim 121 is patentable over Herz and Yuen under 35 U.S.C. §103. Since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also allowable over the combination of Herz, Alexander and Yuen under 35 U.S.C. §103.

Therefore, claims 121-128, 131-136, 141-143, 145, 149, 151, 153-157, 163-164 and 166-168 are patentable over Herz, Alexander and Yuen under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

B. Claims 100-103, 108-110, 116, 117, 129, 130, and 150

The Office Action rejects claims 100-103, 108-110, 116, 117, 129, 130, and 150 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of U.S. Patent No. 5,659,350 to Hendricks et al. ("Hendricks") further in view of Yuen and further in view of Alexander. Applicants respectfully traverse the rejection.

The Office Action fails to establish a *prima facie* case of obviousness, because the combination of Herz, Hendricks, Yuen and Alexander fails to teach or suggest all the claim elements. Applicants respectfully submit that Herz, Hendricks, Yuen and Alexander, alone or in any permissible combination fail to teach or suggest providing program recommendations to the user based on the profile of the user via an interactive programming guide having a top portion and a bottom portion, the top portion providing programming recommendations based on the profile of the user, the bottom portion providing a standard programming guide in numeric order based on a channel number, wherein said interactive programming guide automatically appears when the user turns on a television, as positively recited by Applicants' independent claim 100.

The Examiner concedes that Herz, Hendricks and Yuen fail to teach or suggest this limitation in the Office Action. (See Office Action, p. 20, ll. 11-15). However, the Examiner asserts that Alexander bridges the substantial gap left by Herz, Hendricks and Yuen. Applicants respectfully disagree.

Alexander fails to bridge the substantial gap between Herz, Hendricks and Yuen because Alexander also fails to teach or suggest providing program recommendations to the user based on the profile of the user via an interactive programming guide having

a top portion and a bottom portion, the top portion providing programming recommendations based on the profile of the user, the bottom portion providing a standard programming guide in numeric order based on a channel number, wherein said interactive programming guide automatically appears when the user turns on a television. The Examiner is reminded that the MPEP § 2141.02(VI) requires the Examiner to consider the prior art in its entirety. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention”. MPEP § 2141.02(VI), W.L. Gore & Associates, Inc., v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed Cir. 1983), cert. denied, 469 U.S. 851 (1984)(emphasis added).

Alexander clearly fails to teach or suggest wherein said interactive programming guide automatically appears when the user turns on a television. In fact, Alexander explicitly teaches away from this limitation of Applicants’ invention. Alexander teaches that the viewer enters the Guide Mode by pressing a “select” key. (See Alexander, col. 3, ll. 56-57). In other words, Alexander teaches that a viewer must decide to enter the Guide Mode and manually press the “select” button to enter the guide mode. In stark contrast, Applicants’ invention teaches wherein said interactive programming guide automatically appears when the user turns on a television.

At best, Alexander teaches that the EPG automatically tunes to a channel based upon the user profile. (See Alexander, col. 30, l. 59 – col. 31, l. 8). However, Alexander states that the grid guide may be re-formatted “whenever the viewer enters the Grid Guide.” (See Alexander, col. 31, ll. 6-7, emphasis added). As noted above, Alexander explicitly teaches that the user must enter the Guide Mode by manually pressing the “select” button to enter the guide mode. Thus, Alexander clearly fails to teach or suggest wherein said interactive programming guide automatically appears when the user turns on a television. Thus, in Applicants’ invention, the user may immediately decide which program to watch after turning the user’s television without needing to aimlessly surf channels.

In addition, Alexander teaches an electronic programming guide having a single portion for displaying available programming, whether the programming is in channel order or according to a customized view of the viewer’s favorite channel. (See

Alexander, FIGs. 1-10A). Notably, none of the figures illustrate an EPG that has two separate portions including a top portion and a bottom portion, the top portion providing programming recommendations based on the profile of the user, the bottom portion providing a standard programming guide in numeric order based on a channel number. FIGs. 1-10A only show a single grid portion in a “grid” format, a “sort” format or a “schedule” format. The Applicants would find it helpful if the Examiner could specifically identify a FIG in Alexander or a portion of the specification that the Examiner feels teaches this limitation, rather than general citations. For example, the Examiner’s citation to col. 3, line 21- col. 4, line 27 teaches how the viewer must manually enter the Guide Mode, col. 5, lines 56 – col. 7, line 45 only describes the asserted “improvements to an EPG”, notably none which discuss two separate programming guide portions, col. 14, line 48 – col. 15, line 1+ only discusses on-screen notifications, theme navigation bars, improved scrolling and jumping, col. 30, line 45 – col. 31, line 1+ only teaches that the grid guide may be customized and that a viewer must still manually enter the grid guide, but is silent as to teaching two separate programming guide portions.

In stark contrast, as previously argued, Applicants’ invention teaches two separate programming guide portions. As a result, the viewer is simultaneously presented with both an option to select based on the top portion of the programming guide providing programming recommendations based on the profile of the user or to select based on the bottom portion of the programming guide providing a standard programming guide in numeric order based on a channel number. Thus, Applicants’ invention provides more choices to the viewer than taught by Alexander. Therefore, the combination of Herz, Hendricks, Yuen and Alexander fail to render obvious Applicants independent claim 100.

Independent claims 116 and 117 contain similar limitations and are patentable over Herz, Hendricks, Yuen and Alexander under 35 U.S.C. §103 for at least the same reasons that claim 100 is patentable over Herz, Hendricks, Yuen and Alexander under 35 U.S.C. §103. Since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also allowable over the combination of Herz, Hendricks, Yuen and Alexander under 35 U.S.C. §103. Therefore, claims 100-

103, 108-110, 116 and 117 are patentable over Herz, Hendricks, Yuen and Alexander under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

Furthermore, as discussed above, independent claims 121 and 149 are patentable over Herz, Alexander and Yuen under 35 U.S.C. §103. Since the rejection of the corresponding independent claims under 35 U.S.C. §103 has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Hendricks supplies that which is missing from Herz, Alexander and Yuen to render the independent claims unpatentable, these grounds of rejection cannot be maintained. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn. Therefore, claims 129, 130 and 150 are also patentable over the combination of Herz, Hendricks, Yuen and Alexander under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

C. Claims 104-107

The Office Action rejects claims 104-107 under 35 U.S.C. §103(a) as being unpatentable over Herz in view of Hendricks in view of Yuen in view of Alexander and further in view of U.S. Patent No. 5,223,924 to Strubbe ("Strubbe"). Applicants respectfully traverse the rejection.

Claims 104-107 depend, directly or indirectly, from claim 100 and, thus inherit the patentable subject matter of claim 100, while adding additional elements. Therefore, claims 104-107 are also patentable over Herz, Hendricks, Yuen and Alexander under 35 U.S.C. §103. Furthermore, because Strubbe fails to teach providing program recommendations to the user based on the profile of the user via an interactive programming guide having a top portion and a bottom portion, the top portion providing programming recommendations based on the profile of the user, the bottom portion providing a standard programming guide in numeric order based on a channel number, wherein said interactive programming guide automatically appears when the user turns on a television, claims 104-107 are patentable over the combination of Herz, Hendricks, Yuen, Alexander and Strubbe under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

D. Claims 111-115

The Office Action rejects claims 111-115 under 35 U.S.C. §103(a) as being unpatentable over Herz, Hendricks and Yuen in view of Alexander and further in view of U.S. Patent No. 5,848,396 to Gerace ("Gerace"). Applicants respectfully traverse the rejection.

Claims 111-115 depend, directly or indirectly, from claim 100 and, thus inherit the patentable subject matter of claim 100, while adding additional elements. Therefore, claims 111-115 are also patentable over Herz, Hendricks, Yuen and Alexander under 35 U.S.C. §103. Furthermore, because Gerace fails to teach providing program recommendations to the user based on the profile of the user via an interactive programming guide having a top portion and a bottom portion, the top portion providing programming recommendations based on the profile of the user, the bottom portion providing a standard programming guide in numeric order based on a channel number, wherein said interactive programming guide automatically appears when the user turns on a television, claims 111-115 are patentable over the combination of Herz, Hendricks, Yuen, Alexander and Gerace under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.

E. Claims 137-139 and 147

The Office Action rejects claims 137-139 and 147 under 35 U.S.C. §103(a) as being unpatentable over Herz and Yuen in view of Alexander and further in view of U.S. Patent No. 6,005,597 to Barrett et al. ("Barrett"). Applicants note that claim 147 is cancelled and respectfully traverse the rejection.

Claims 137-139 depend from claim 121 and, thus inherit the patentable subject matter of claim 121, while adding additional elements. Therefore, claims 137-139 are patentable over Herz, Yuen and Alexander under 37 C.F.R. §103. Furthermore, Barrett fails to teach providing program recommendations to the user based on the profile of the user via an interactive programming guide having a top portion and a bottom portion, the top portion providing programming recommendations based on the profile of the user, the bottom portion providing a standard programming guide in numeric order based on a channel number, wherein said interactive programming guide

automatically appears when the user turns on a television. Notably, Barrett only teaches providing the highest ranking programs to the user in the main viewing area of a television screen and using picture in picture for the next highest ranking program. (See Barrett, col. 4, ll. 14-18). Therefore, claims 137-139 are patentable over the combination of Herz, Yuen, Alexander and Barrett under 35 U.S.C. §103. Therefore, the rejection should be withdrawn.


CONCLUSION

Applicants believe that the claims are in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 12/22/08.



Eamon J. Wall, Attorney
Reg. No. 39,414
(732) 530-9404

Patterson & Sheridan, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702